

THIS DISPOSITION
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Mailed: November 17, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Held

Serial No. 76513336

Paul M. Denk for Robert F. Held.

Dezmona Mizelle-Howard, Trademark Examining Attorney, Law
Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Hohein, Zervas and Kuhlke, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

Robert F. Held has appealed from the final refusal of
the trademark examining attorney to register SPRING BERRIES
(in standard character form) as a trademark for "an air
freshener that applies directly onto an air vent register."¹

¹ Application Serial No. 76513336, filed April 28, 2003,
asserting a bona fide intention to use the mark in commerce under
Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

We note that on January 13, 2005, applicant filed three
separate papers, namely, an appeal, a request for reconsideration
and a statement of use. The record does not reflect that the
examining attorney has acted on the amendment to allege use.

The examining attorney has set forth two grounds for refusal of the application in the final Office action. First, the examining attorney has required a disclaimer of the wording BERRIES pursuant to Section 6 of the Trademark Act, 15 U.S.C. §1056. Second, the examining attorney has refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the previously registered mark SPRING MULBERRIES (in standard character form) for "scented air fresheners"² that, as used on applicant's identified goods, it is likely to cause confusion or mistake or to deceive. The cited registration contains a disclaimer of the exclusive right to use MULBERRIES apart from the mark in its entirety.

After the refusal was made final, applicant appealed and filed a request for reconsideration. The request for reconsideration includes the following:

- (a) a proposed amendment to the identification of goods, namely to "[a]ir freshener that applies directly to the intake vent of an air vent register";
- (b) a disclaimer of the exclusive right to use BERRIES apart from the mark as shown in the application;

Thus, the application involved in this appeal remains as an intent-to-use application.

² Registration No. 2250534, issued June 1, 1999. Section 8 and 15 affidavits accepted and acknowledged.

(c) arguments against the refusal to register under Section 2(d).

(d) a proposed amendment of the application from the Principal Register to the Supplemental Register.

Additionally, applicant filed an amendment to allege use.

See footnote 1, *supra*.

On March 30, 2005, the examining attorney issued a denial of the request for reconsideration, stating:

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Accordingly, applicant's request for reconsideration is denied. The time for appeal runs from the date the final action was mailed.

The examining attorney did not address applicant's disclaimer of the term BERRIES as the examining attorney required in the final Office action, or the proposed amendments to the identification of goods and to the Supplemental Register.³ In her brief, the examining attorney mentions these filings but does not state what

³ The Office's electronic database does not reflect that the disclaimer, the amended identification of goods or the amendment to the Supplemental Register have been entered.

action was taken on such filings. She simply states that the "request for reconsideration was denied by [the] examining attorney"⁴

After the examining attorney's denial of the request for reconsideration, the appeal was resumed. Applicant and the examining attorney have filed briefs.⁵ Applicant did not request an oral hearing.

We affirm the Section 2(d) refusal of registration. Consideration of the examining attorney's disclaimer requirement at this time is therefore moot.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d

⁴ We note that even if the examining attorney had approved applicant's disclaimer and allowed applicant's proposed amendment to the Supplemental Register, the disclaimer and the amendment to the Supplemental Register would not have overcome the examining attorney's Section 2(d) refusal. Applications for registration on the Supplemental Register may be refused registration under Section 2(d). See TMEP § 1207.

⁵ The examining attorney has referred to certain "attachments" in her brief at p. 7, and, although the record is not entirely clear, it appears that the examining attorney did not earlier introduce such "attachments" into the record. The record in the application should be complete prior to the filing of an appeal, and the Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. See Trademark Rule 2.142(d) and TBMP § 1207.01 (2d ed. rev. 2004). Thus, we have not further considered either the website evidence regarding air fresheners nor the third-party registrations which include a disclaimer of the term BERRY.

1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We initially turn to the similarities between registrant's and applicant's goods. Because applicant's identification of goods does not specify whether applicant's air fresheners are scented or unscented, applicant's identification includes scented air fresheners. Both party's goods, therefore, are "scented air fresheners."⁶ Although applicant adds in its identification of goods that its goods are "applie[d] directly onto an air vent register," registrant's identification of goods is not restricted in terms of the manner of use, and hence, for purposes of the likelihood of confusion analysis, encompasses scented air fresheners that are applied

⁶ Applicant has characterized its goods as scented air fresheners. See Applicant's Brief at p. 5 ("[T]he freshness emanates from the vent that conveys the air back into the various rooms, having picked up the scent from the intake vent, where the device is applied.").

directly onto an air vent register or directly to the intake vent of an air vent register. Thus, applicant's argument regarding the manner of use of its goods is irrelevant to our analysis. ("[A]pplicant's product is a very specific type of air freshener, it is not one that is sprayed around the room like most air fresheners, it is more of a device, that is applied directly to the air vent register, particularly the intake air register, as a compact small air refreshing device." Applicant's Brief at p. 5.) We therefore find that applicant's and registrant's goods are legally identical.

We next consider the similarities of the marks. We do not consider whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In comparing marks in their entireties, it is completely appropriate to give less weight to a portion of a mark that is merely descriptive of the relevant goods or services. *In re National Data Corp.*, 753 F.2d 1056, 224

USPQ 749 (Fed. Cir. 1985). ("That a particular feature is descriptive ... with respect to the relevant goods or services is one commonly accepted rationale for giving less weight to a portion of the mark.").

Both of the two-word marks at issue begin with the word SPRING. Applicant has not made of record any evidence whatsoever showing that SPRING is in any way descriptive of either his goods or registrant's goods.

The words BERRIES (part of applicant's mark) and MULBERRIES (part of registrant's mark) are merely descriptive of the goods of applicant and registrant. Registrant has disclaimed MULBERRIES and applicant has sought to disclaim BERRIES. Clearly, as applied to air fresheners, both BERRIES and MULBERRIES describe the scent of the air freshener.

Not only is the word SPRING the dominant portion of both marks, but in addition, it is "the first word" in both marks, an additional factor which makes "the marks similar." *Palm Bay Imports, Inc. v. Veuve Clicquot*, 396 F.3d 1396, 73 USPQ2d 1689 (Fed. Cir. 2005). See also *Presto Products v. Nice-Pak Products*, 9 USPQ2d 1895 (TTAB 1998) ("The fact that two marks share the same word is generally a matter of some importance since it is often the

first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.")

Finally, it must be remembered that both applicant's mark and registrant's mark are in standard character or typed form. This means that the two marks are not limited to being "depicted in any special form," and hence we are mandated to "visualize what other forms the mark[s] might appear in." *Phillips Petroleum Co. v. C. J. Webb Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971). See also *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585 (TTAB 1992). One reasonable manner of presentation for both marks would be to depict SPRING in large lettering on one line, and then depict the subordinate elements (BERRIES or MULBERRIES) in decidedly smaller lettering on a second line. When so depicted, the two marks would be extremely similar, and their use on legally identical goods would result in not a mere likelihood of confusion, but rather an extremely high probability of confusion.

Applicant has argued that SPRING "is quite common, well registered, and [for] all or the same or related products" as in the present application and cites to numerous use-based, third-party registrations made of

record with applicant's request for reconsideration.⁷

Although third-party registrations can be used to show that a registered mark is weak, see *Conde Nast Publications Inc. v. Miss Quality, Inc.*, 180 USPQ 149 (TTAB 1973), the mere presence of the same "weak" term in two marks does not automatically mean that confusion is not likely. Even weak marks are entitled to protection against the registration of a similar mark for identical goods. See *Plus Products v. Pharmavite Pharmaceutical Corp.*, 221 USPQ 256 (TTAB 1984). See also *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974) (likelihood of confusion is to be avoided as much between weak marks as between strong marks). Moreover, as to the marks at issue herein, the structure and overall impression of applicant's and registrant's marks are much more similar than those in the third-party registrations. Both marks begin with SPRING and end with BERRIES. Further, as the examining attorney stated, "while applicant has provided instances

⁷ We have not considered, however, the applications submitted with the request for reconsideration because they are probative only of the fact that they have been filed. Also, we have not considered the cancelled registrations - cancelled registrations are not evidence of anything except that they issued. Further, we have not considered those records for which a registration number is not apparent because such records are incomplete and their existence cannot be readily be verified.

where SPRING is included in connection with the same or similar goods, applicant has not provided evidence that SPRING in connection with BERRIES or variations of BERRIES is weak in connection with air fresheners." Thus, applicant's argument is not well taken.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.⁸

⁸ If this case is appealed and our decision herein is reversed, the application will be returned to the examining attorney for consideration of (a) the amendment to allege use, (b) the proposed amendment to the identification of goods, (c) the disclaimer, and (d) the proposed amendment to the Supplemental Register.